



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,309	12/16/2003	Makoto Kawai	PC25538A	5957
28880	7590	05/16/2006	EXAMINER	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			DAVIS, ZINNA NORTINGTON	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/737,309	KAWAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Zinna Northington Davis	1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 11, 13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 5-7, 10, and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3/06</u> | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claims 1-13, 15, and 16 are pending.
2. Claim 14 is withdrawn. This claim has not been canceled.
3. This action is in response to the Amendment filed March 2, 2006. Claims 1-13, 15, and 16, are elected without traverse.
4. Based upon the Amendment filed March 2, 2006, the rejection under 35 U.S.C. § 112, 1<sup>st</sup> paragraph is withdrawn.
5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
7. Claims 1- 4, 8, 9, 11, 13, 15 and 16 are **again** rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kato et al (Reference U).

The instantly claimed compound is disclosed. See RN 118912-52-0. At page 72, see compound 57. The claims are fully met when R<sup>2</sup>, R<sup>3</sup>, and R<sup>6</sup> represent H; R<sup>4</sup>

Art Unit: 1625

represents phenyl substituted by halogen; Z represents C; R<sup>5</sup> represent –OH; A represents pyrazolyl; and X represents CH<sub>2</sub>CH<sub>2</sub>O.

8. Claims 1- 4, 8, 9, 11, 13, 15 and 16 are **again** rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kato et al (Reference V).

The instantly claimed compound is disclosed. See RN 110731-75-4. At page 581, see compound 57. The claims are fully met when R<sup>2</sup>, R<sup>3</sup>, and R<sup>6</sup> represent H; R<sup>4</sup> represents phenyl substituted by halogen; Z represents C; R<sup>5</sup> represent –OH; A represents pyrazolyl; and X represents CH<sub>2</sub>O.

**Response to Applicants Remarks about the**

**Rejection under 35 U.S.C. §102(b)**

9. Applicants submit that the compounds of the present invention do not include compounds wherein "A" is pyrazolyl. In claim 1 of the pending application, the term "A" represents a cycloalkylene group having from 3 to 10 carbon atoms or a heterocyclic group having from 4 to 10 atoms. The terms "cycloalkylene group" and "heterocyclic group" as defined on page 11, lines 17-30 of the specification, do not include pyrazolyl. The pyrazolyl group falls within the definition of "heteroaryl" as defined on page 12, lines 4- 11 of the specification.

In light of the foregoing, the Applicants respectfully submit that the compounds of the present invention are novel over the Kato et al references and respectfully request that the rejections be withdrawn.

It is the Examiner's position that:

Art Unit: 1625

- The compounds of the present invention do include compounds wherein "A" is pyrazolyl.
- As defined on page 11, lines 23-25, the term "A" represents heterocyclic group having from 4 to 10-membered saturated, partially saturated ring, which consists of at least one carbon atom and from 1 to 4 heteroatoms independently selected from sulfur atoms, oxygen atoms and nitrogen atoms.
- As defined on page 11, lines 25-30, examples of such heterocycles include, *but are limited to*, piperidine, 4-piperidone, pyrrolidine, 2-pyrrolidone, tetrahydrofurane, tetrahydroquinoline, tetrahydroisoquinoline, decahydroquinoline or octahydroisoquinoline, pyrrolidine, piperidine or piperazine.
- It is true that the pyrazolyl group falls within the definition of "heteroaryl" as defined on page 12, lines 4- 11 of the specification.
- However, a pyrazolyl ring is both a heteroaryl ring and a heterocyclic ring.
- While every heterocyclic ring may not be a heteroaryl ring, every heteroaryl ring must be a heterocyclic ring.
- Applicant's arguments filed March 2, 2006 have been fully considered but they are not persuasive.

10. Claims 5-7, 10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

Art Unit: 1625

limitations of the base claim and any intervening claims to the extent that the claims read on the examined subject matter as recited above.

11. The Information Disclosure Statement filed March 9, 2006 has been considered. The references alone or in combination forms do not teach nor suggest the structurally similar compounds as the examined subject matter.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

14. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1625

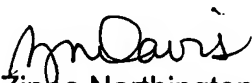
published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

  
Zinna Northington Davis  
Primary Examiner  
Art Unit 1625

Znd  
05.15.2006